

REMARKS

Claims 1-7 and 11-14 are currently pending in the application. Applicant has amended claim 1 and added claims 11-14. Applicant requests reconsideration of the application in light of the following remarks.

Change of Address

The office action was sent to Weiss & Moy PC. Applicant respectfully requests that all future correspondence for this patent application be sent to:

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Telephone Interview

Applicant's attorney wishes to thank the Examiner for his courtesy and time during a telephone interview that was held on November 4, 2004. The Examiner's comments and insight were very helpful in preparing this response. It is hoped that the comments below reflect the spirit of the interview.

Generally

The terms "interpretation" and/or variations and "verbal" have been introduced by this amendment. These terms are considered to be inherently supported by the original disclosure since the original disclosure describes translation by a human translator, which inherently requires interpretation of the message by the translator; and speaking the words of the translation, which is inherently verbal.

Rejections under 35 U.S.C. §103

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants' disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP §2143.

Claims 1-2 and 4-7

Claims 1-2 and 4-7 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Bennett et al. (U.S. Patent No. 5,884,256, hereinafter “Bennett”). Applicants respectfully traverse this rejection and request reconsideration of the claims.

Bennett fails to provide all of the claim limitations of Claim 1. As a clear indication of how Bennett is completely different from the present invention, Bennett's stenographic device 11 device does not include an integral recording device that is repeatedly played back and relied upon for consecutive delivery of simultaneous interpretation and translation by a human translator. Rather, Bennett has a tape recorder 351 that may be connected to a computer aided transcription (CAT) system 13, for the purpose of aiding in perfecting a court record after the stenographer has made a record of the court proceedings by a conventional keystroke method. The words are not typically played back to the stenographer at the trial, but are played back off-site to a person for the purpose of aiding that person in perfecting the previously transcribed record. The playback and perfecting of the record may occur hours later as opposed to the

“simultaneous[ly] … translat[ion]” and delivery of “a consecutive translation” of the present method, as recited in claim 1, lines 10-12. However, in the event that a recording is played back during trial, it is to enable the stenographer to enter the key strokes representing phonemes that are then transcribed into text and subsequently translated by the CAT system 13 into the target language as set forth in column 16, lines 60-67. Bennett is silent as to simultaneous translation while words are being played back as now required by claim 1. Furthermore, Claim 1 now recites “said human translator verbally delivering a translation consecutively in real time with an accuracy of a simultaneous translation”, which is not a step disclosed or made obvious by Bennett. In fact, Bennett teaches away from use of a human translator as set forth in column 16, lines 41-42, which state that by the machine of Bennett, the use of a human translator can be minimized. Furthermore, Bennett attempts to solve the problems of bad machine translation by machine implemented solutions and not by a human translator, as indicated in column 16, lines 43-45. This is evidence that Bennett teaches away from translation by a human translator, which is critical for the method of claims 1-7.

Even though the stenographic device 11 of Bennett is capable of use with a tape recorder 351, Bennett does not teach the steps of “utilizing the recording device to play back” a recorded message for the purpose of “verbally delivering a consecutive translation in real time relative to the step of hearing the words spoken in the source language”, as recited in claim 1, lines 8 and 12-13, and “simultaneously interpreting and translating said words in said source language into a target language while they are being played back” by a human translator as recited in lines 10-11. Nor would it be obvious to do so because it would not accomplish anything toward the purpose of Bennett, which is to create an accurately transcribed, textual message. An important benefit of the present method of translating is that it enables an uninterrupted flow of court proceedings. Furthermore, it enables delivery of a consecutive translation with an accuracy of a simultaneous

translation. Bennett's non-instantaneous search and playback (described below), on the other hand, would result in repeated delays and interruptions of the proceedings if an attempt were made to use Bennett's system in accordance with the present invention. Furthermore, such an attempt would require the improper hindsight view of the teachings of the present invention.

The lack of teaching by Bennett and the lack of obviousness in light of Bennett is particularly apparent from the disclosure of Bennett with regard to markers in the recording or the step of recording a tape position for subsequent searching for the mark or position and replaying as set forth in the paragraphs of column 25, line 37 to column 26, line 26. Bennett has no teaching of "a means for playing back said words spoken in said source language substantially instantaneously" as now recited in Claim 1, lines 6-7. Rather, the searching and replaying described in Bennett's disclosure contemplates that the replay will be effectuated after more than one message has been recorded. Thus, the type of searching and replaying described by Bennett would not correspond to the delivery of translations in accordance with the term of art "consecutive translation". The marking, searching and replaying of Bennett teaches away from the simultaneous translation and consecutive delivery of the present invention. The method of the present invention may utilize a recording device that is capable of storing one message in memory at a time so that plural markers and searching for multiple markers is not required. Therefore, the method of the present invention as defined in claim 1 as utilizing a means for instantaneously playing back, simultaneously translating, and consecutively delivering a verbal message defines over Bennett.

Notably, the reference to translation in column 16, lines 37-45 does not describe use of the tape recorder 351 as an aid to verbal interpretation and translation from a source language to a target language as now recited in claim 1, lines 10-13. Rather, Bennett discloses that the text is translated by the machine 11 by association of words of a first source language in a first table 235

with words of a second target language in a second table 237. Therefore claim 1 is considered to be allowable and withdrawal of the rejection of claim 1 under 35 USC is earnestly solicited.

Claims 2 and 4-7 are considered to be allowable as depending from allowable base claim 1. Applicant therefore respectfully requests that the obviousness rejections of claims 2 and 4-7 be withdrawn.

Claim 3

Claim 3 is considered to be allowable as depending from allowable base claim 1. Applicant therefore respectfully requests that the obviousness rejections of claim 3 be withdrawn.

New Claims

New claims 11-14 have been submitted herewith. Claims 11-14 include limitations that similarly define over the art of record, and allowance of claims 11-14 is therefore requested.

Regarding Doctrine of Equivalents

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

CONCLUSION

Claims 1-7 and 11-14 are considered to be patentable, and allowance of all the claims is therefore requested. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

The amendments herein added 2 new independent and 2 new dependent claims, resulting in no additional fees due.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 19-0513. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

Date: November 10, 2004

By



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